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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/465,415

12/16/1999

BRYAN SEVERT HALLBERG

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01/11/2006

CHERNOFF, VILHAUER, MCCLUNG & STENZEL, LLP
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EXAMINER

BOCCIO, VINCENT F

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/465,415

Applicant(s)

HALLBERG ET AL.

Examiner

Vincent F. Boccio

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment of 10/31/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2616.

Response to Arguments

1. Applicant's arguments filed 10/31/05 have been fully considered but they are not persuasive.

{A} In re page 7, applicant states, "Okuyama indicate that MPEG and DV, while transported on the same IEEE 1394 stream to the recording device are process separately and are no point is any MPEG data inserted into DIF block" and "Okuyama ... none of the MPEG data is ever inserted into a DIF block. In fact, if there were no DV input device connected to the system, there would be no DIF block within which the MPEG data could be inserted."

In response the primary examiner believes applicant should review the reference in the entirety, as on the last action the examiner had cited multiple cols. and had col. 14 etc....., suggesting reading the entire reference.

The primary examiner more clearly understands what is not clear, based on the argument present and the claim language chosen and used, after a careful review of the claims and specification.

The claims basically recite, copying the MPEG stream to DIF type format and storing in that format.

The examiner suggests that the copying really is a format conversion step, which at col. 14, met by element 43, wherein if applicant had carefully read the reference, would have come to the conclusion that this element converts the format, wherein Okuyama, does disclose that element 43 is a format converter converting the MPEG2 transport stream into the DVC format data wherein the DVC standard having DIF blocks, therefore, does disclose MPEG2 transport conversion, rather than mere copying, to DVC being the recited, DIF block format, element 43.

The disclosure of Okuyama is relevant to the conversion element is at cols. 14-16, as the primary examiner has suggested at page 3 to read the reference as a whole, by citing on page 3 of the last action col. 14 etc.....

The primary examiner of record states for the record, the language used in the claims is not deemed the best language to be used, in view of the language copying MPEG to DIF is not just

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copying, but, really is format conversion, which using language that is not the best choice of wording does cause scope and understanding comprehension difficult for any examiner and also applicant.

Therefore, the examiner believes the reference should have reviewed in the entirety, applicant has stated that the prior art reference Okuyama, does not teach the limitation argued, the examiner fails to agree and therefore, the arguments are not persuasive and the grounds of rejection has been maintained.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claim 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al. (US 5,832,085) in view of Okuyama et al. (US 5,987,126).

The examiner incorporates by reference the rejection against the claims since not amended.

3. Claims 5-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Inoue et al. (US

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5,832,085) and Okuyama (US 5,987,126), as applied, and further in view of Oskouy et al. (US 6,791,947).

The examiner incorporates by reference the rejection of record against the claims since not amended.

4. Claims 16-17 and amended claim 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Inoue et al. (US 5,832,085) and Okuyama (US 5,987,126) as applied, in view of Yanagihara et al. (US 5,684,917).

The examiner incorporates by reference the last detailed action against the claims and further renders obvious the combination with Yanagihara, claims 16-17.

The rejection of claim 18 is incorporated by reference and is under new grounds of rejection and obvious further in view of Okuyama, as the combination, as applied previously, as applied above.

5. Claim 19 (amended) is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Inoue et al. (US 5,832,085), Okuyama (US 5,987,126) and Yanagihara et al. (US 5,684,917) in view of Takeda et al. (US 6,101,215).

The rejection of claim 19 is incorporated by reference and is under new grounds of rejection as being obvious further in view of Okuyama, as applied above.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Fax Information

Any response to this action should be faxed to:

(571) 273-8300, for communication as intended for entry,
this Central Fax Number as of 7/15/05

Contact Information

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Tuesday & Thursday-Friday, 8:00 AM to 5:00 PM Vincent F. Boccio (571) 272-7373.

Primary Examiner, Boccio, Vincent
1/8/06


VINCENT BOCCIO
PRIMARY EXAMINER